

REMARKS

The Official Action of January 29, 2004 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 5 has been amended in the manner courteously suggested by the Examiner to remove the basis for the rejection to this claim at paragraph 3 of the Official Action. All claims presently on file are believed to be sufficiently definite to satisfy the dictates of 35 USC 112, second paragraph.

Claims 1, 3 and 8-10 stand rejected under 35 USC 103(a) as allegedly being unpatentable over JP 11217525 in view of Sano et al or, alternatively, over Anton et al in view of Sano et al. Applicants respectfully traverse these rejections.

The Applicants have previously submitted the Declaration under 37 CFR 1.132 of one of the co-inventors, Kazuaki Watanabe, to show the advantageous results that can be achieved with the claimed ink composition as compared with the ink compositions of the closest prior art reference. In the Official Action in the paragraph bridging pages 5 and 6 and in the first full paragraph on page 6, the Examiner acknowledges that, as shown by the comparison of the claimed ink comprising the recited compound of formula (1) and triethylene glycol monobutyl ether with comparative Ink Set G comprising diethylene glycol monobutyl ether only, the claimed inks are superior in terms of cohesion, gloss, fixing ability, bronzing and

ejection stability. The Examiner nevertheless contends that the declaration does not establish unexpected or surprising results over the cited prior art because Sano et al already recognized the criticality of using a combination of acetylene glycol surfactant and triethylene glycol monobutyl ether in order to produce ink with the **necessary penetrating capacity**.

First, Applicants respectfully note that one of skill in the art could not predict the effects of improving **gloss differential** and **glossiness** based on the teaching of a penetrating property-imparting effect. Moreover, the Examiner has respectfully overlooked the fact that, in addition to showing the advantages of using the specific combination of ultra-penetrating agents as claimed, the declaration also clearly shows the advantages provided by using the claimed emulsion of a sulfonyl group-containing (co)polymer in combination with the claimed ultra-penetrating agents. Specifically, in addition to comparing the claimed ink with Ink Set G, which does not contain the claimed combination of ultra-penetrating agents (see declaration at Comparative Example 2), the declaration also compares the claimed ink with Ink Set F, which contains the claimed combination of ultra-penetrating agents but does not contain the claimed emulsion of sulfonyl group-containing (co)polymer (see declaration at Comparative Example 1).

As shown in the declaration, both Ink Set F and Ink Set G resulted in a score of C in the evaluations for "gloss differential" and "glossiness". In contrast, Ink Set A containing both the claimed emulsion and the claimed specific combination of ultra-

penetrating agents resulted in a score of A in these evaluations. (See specification at pages 33 and 34 for an explanation of the evaluation scores.)

The above results establish the criticality of the use of the claimed emulsion of a sulfonyl group-containing (co)polymer in combination with the claimed ultra-penetrating agents. These results are not shown or suggested in the prior art and thus must be considered to have been unexpected and probative of nonobviousness. As noted above, one of skill in the art could not have predicted an improvement of gloss differential and glossiness based on a teaching of a penetrating property-imparting effect. *A fortiori*, one of skill in the art could not have predicted such improvement in the absence of any teaching as to the criticality of using the claimed emulsion with the claimed combination of ultra-penetrating agents.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

CLIFFORD J. MASS
LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG. NO.30,086(212)708-1890